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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,686	11/16/2001	Lee Kirby Jameson	17,090B	2950
23556	7590	03/23/2006	EXAMINER	
KIMBERLY-CLARK WORLDWIDE, INC.			REICHLER, KARIN M	
401 NORTH LAKE STREET			ART UNIT	
NEENAH, WI 54956			PAPER NUMBER	

3761

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,686

Applicant(s)

JAMESON ET AL.

Examiner

Karin M. Reichle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-11, 24 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3-6-06 has been entered.

Election/Restrictions

2. Claims 1-11 and 24-25 continue to be withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 11.

Specification

3. It is noted that the amendment to page 9, starting at line 24 was previously made in Applicant's 4-8-04 response.

4. The disclosure is objected to because of the following informalities: The originally filed specification set forth at page 8, lines 19-20 that the discrete segments of the absorbent article, i.e. segments which have been applied, have a volume of about 5 to about 400 nanoliters and the paragraph bridging pages 8-9 uses the terminology "droplets" and "discrete segments" interchangeably, and thereby the specification is considered to describe droplets which once

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applied to the absorbent article also have such volume. Note also originally filed claim 22. The original specification also described droplets to be applied having a diameter of 1-2mm in the paragraph bridging pages 8-9 and droplets to be applied of a diameter in the range of 50-90 micrometers. The claims, specifically the last subsection of claim 1, now claims droplets having a volume in the range of about 5 nanoliters to about 400 nanoliters and such droplets are applied, not have been applied, to the substrate so as to produce a substrate having topographical characteristics. Therefore, at the very least, the description of the volume of the droplets and when such volume exists now appears to be inconsistent throughout the specification. A clear, consistent description of the volume of the droplets/segments prior to application and after application to the substrate of the absorbent article which is supported by the originally filed application should be set forth. If Applicant maintains the present claim language, the portion of the originally filed specification which disclose such features in a single embodiment should be set forth.

Appropriate correction is required.

Drawings

5. The petition to accept color photographs filed 11-27-01 has been placed in the application. It should be noted that such petition is decided by the SPE. Therefore, the application will be forwarded to the current SPE after mailing of this action for decision of the petition. It should be noted that the substitute drawings filed 4-15-02 includes only one set of the photographs.

Claim Rejections - 35 USC § 112

6. Claims 12-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As discussed supra, in paragraph 4, it is unclear when the droplets have the claimed volume? When applied? After application, i.e. in the end product? Applicant's attention is also invited to claim 23, i.e. if the end product is claimed as having the volume in claim 12, lines 2-3 of claim 23 are redundant.

Claim Language Interpretation

7. Due to the lack of consistency and clarity discussed supra and in light of the specification portions discussed supra and especially in light of page 8, line 31-page 9, line 1 and claims 22-23, i.e. absent specific claiming thereof, no specific shape is required thereby, the article of claim 1 is considered to be an absorbent article comprising a substrate with a first surface and droplets comprising chemistries as claimed on lines 3-4 on the substrate so that the substrate has topographical characteristics, i.e. topographical function, capability or property, and the droplets have a volume in the range as claimed on lines 5-6 at some time, i.e. before application or in combination with the substrate, i.e. after application. If interpreted as having such volume before application, claim 1 and, in either case, claims 14-16 and 19 are product by process claims. As set forth in MPEP 2113, it is the structure of the end product of the process which determines patentability not the process. Therefore, in the former situation in claim 1, i.e. the volume of the claim is considered to be that before application, since the volume of the drops

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being claimed after application, i.e. the end product, is unknown, any or a volume will be considered to read on it. Claims 14-16 and 19 are considered to require a substrate with an arrangement of droplets in claim 14, a substrate with droplets arranged in a pattern, i.e. random or nonrandom, in claim 15, and a substrate with an arrangement of droplets having the capability, function or property claimed in claims 16 and 19. "Chemistries" is interpreted in light of page 8, lines 20-25. "Phase change liquid" is defined as set forth on page 5, fourth full paragraph and page 7, first full paragraph. "Nonwoven" is defined as set forth on page 5, first full paragraph. "Personal care product" is defined as set forth on page 5, second full paragraph. "Topography of chemistry" is interpreted in light of page 8, lines 3-9. The term "hydrophobic" has not been specifically defined. The dictionary defines such as "antagonistic to, shedding, tending not to combine with or incapable of dissolving in water".

Claim Rejections - 35 USC § 102/103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 12 and 14-22 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 USC 103(a) as obvious in view of Webster '787.

See Figures, i.e. the substrate is 3 and the droplets are 2. The droplets 2 of the end product have a volume, i.e. see discussion set forth in Claim Language Interpretation Section

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supra, and Webster at abstract (applies to claims 12, 14-21), paragraph bridging cols. 1- 2 (applies to claim 12, last two lines, claims 16-19), col. 3, lines 14-22 (applies to all the claims), col. 4, line 1-col. 5, line 14 (applies especially to lines 3-4 of claim 12, claims 14, and 22) and col. 7, lines 22-31 (applies to lines 3-4 of claim 12). With regard to claim 22, a hemisphere is set forth in col. 4, lines 40-41. Therefore, the Webster reference teaches or necessarily and inevitably teaches the end product of claim 1 as best understood.

10. Claims 12-23 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Hayford '998.

With regard to claim 12, see Claim Language Interpretation section supra, the Figures, col. 1, lines 4-6, col. 3, lines 69 et seq, col. 1, lines 46-55, col. 3, line 3-46 and col. 4, lines 10-53, i.e. an absorbent article, e.g. a diaper, comprising a substrate 2, having at least a first surface and droplets 3 or 3 and 4 comprising one or more chemistries, e.g. disinfectants, paraffins, i.e. waxes, oils, gelatins, at least one of the chemistries being at least in part, a phase-change liquid, e.g. paraffin, gelatin, gum arabic, the droplets, e.g., 3, are spherically shaped and have a volume in the range of about 5 nanoliters to about 400 nanoliters, see col. 2, lines 16-19 and are applied to the substrate so as to produce a substrate having topographical characteristics, see Figures 1 and 4, and skin health benefits, e.g. conditioning of the skin. Therefore the Hayford device includes the same structure or obviously includes the same structure, as best understood, of the claimed article or end product.

Claim 13: The substrate 2 can be a nowoven, see col. 4, lines 10-11.

Claims 14-15: The droplets are selectively applied to the substrate, i.e. in a pattern, see col. 4, lines 30-31. It is noted that no specific pattern is claimed.

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Claim 16: The droplets are applied to the substrate so as to create a topography of chemistry, and the topography provides skin health benefits, see the discussion of claim 12.

Claims 17-19: Such claims recite properties, functions or capabilities of the structure of the claimed end product. Hayford includes the structure claimed and disclosed as providing such properties, functions and capabilities in the instant application, e.g. semicircular cross section, medicament compositions including lotions and waxes, discrete segments of the disclosed and claimed volume. Therefore there is sufficient factual basis for one to conclude that the properties, function and capabilities of the claimed structure would also be inherent in or also necessarily and inevitably flow from the same structure of the Hayford device.

Claims 20-21: The substrate is a component of a diaper.

Claim 22: see Figure 1, the spheres 4 stick out of matrix 6, i.e. extend above the surface of the matrix and the portions sticking out are “substantially” semi-spherical in cross section, see also col. 2, line 18.

Claim 23: See discussion of claims 12 and 22 and col. 2, lines 39-49, i.e. the oils listed tend not to combine with water, see Claim Language Interpretation section supra, i.e. are “hydrophobic”.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 12-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-22, 45-46 and 52-53 of copending Application No. 09/990,697. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the instant application was filed after the effective filing date of the '697 application, the one way In re Vogel test applies, i.e. are the claims of the instant application obvious in view of the claims of the '697 application? The answer is yes. With regard to claims 12, 14-16 and 20-22, as best understood, see Claim Language Interpretation section supra, see claims 14-22 of the '697 application as well as the definition of terms at page 6, lines 13-17 and 24-28, page 7, lines 3-7, page 10, line 16-page 12, line 32 of '697, especially page 12, lines 7-9 (and thereby, e.g., col. 13, line 56-col. 14, line 10 of '934 and col. 18, lines 10-30 of '890, i.e. phase change). Note also page 17, lines 7-20 and claim 16 of '697. Attention is also reinvited to the Claim Language Interpretation section supra. Therefore, the instant application with regard to the enumerated claims is both 1) broader than the '697 claims and 2) narrower than the '697 claims. With regard to 1), once an applicant has received a patent for a species on a more specific embodiment which would be the case if '697 issued, he/she is not entitled to a patent for the generic or broader invention. This is because the more specific anticipates the broader. See In re Goodman, supra. With regard to 2), see discussion of claim 23 infra. With regard to claim 13, the instant application claims more

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specific types of substrates than merely the porous substrate claimed in claims 14-22 of '697.

However, porous materials of film, woven, nonwoven, paper and laminates or combinations thereof are well known in the absorbent article art for forming topsheets. Therefore, to employ such types of porous materials as the topsheet in the claims of '697 would be obvious to one of ordinary skill in the art in view of the recognition that such materials are porous and the desire of a topsheet of porous material by the '697 claims. In regard to claims 17-19, such claims recite properties, functions or capabilities of the structure of the claimed end product. The '697 claims include the structure claimed and disclosed as providing such properties, functions and capabilities in the instant application, e.g. semicircular cross section, medicament compositions including lotions and waxes, discrete segments of the disclosed and claimed height. Therefore there is sufficient factual basis for one to conclude that the properties, function and capabilities of the claimed structure would also necessarily and inevitably flow from the same structure of the '697 claims. With regard to claim 23, the claim recites a more narrow range of volume than that of the '697 claims. However, where the general conditions of a claim are disclosed in the prior art, e.g. skin health benefits and the general range in the '697 claims, it is not inventive to discover the optimum or workable ranges by routine experimentation, see *In re Aller et al*, 105 USPQ 233. With regard to the hydrophobic limitation added to claim 23, see the portions of '697 cited *supra*, i.e. medicament compositions including, e.g., emulsions, lipids.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Common Ownership

13. Applicant's statement of common ownership on page 6, first full paragraph of the 3-6-06 response is noted.

Response to Arguments

14. Applicant's remarks of 3-6-06 have been considered but are either deemed moot in that the issue discussed has not been reraised or deemed not persuasive for the reasons set forth supra. Specifically with regard to Webster, Applicant's remarks appear to be narrower than the invention, as best understood, i.e. see paragraph 4 and the portions of the specification cited therein and the Claim Language Interpretation section, i.e. the volume of the droplets before application which was originally disclosed is not the volume claimed and don't know what the volume would be in the end product even if such volume did exist before application. It is further noted that the specification clearly discloses, see portions of the specification cited supra, the shape of the droplet, except where specifically set forth, e.g. as claimed in claims 22 and 23, could be any shape.


Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Karin M. Reichle
Primary Examiner
Art Unit 3761

KMR

March 15, 2006